

REMARKS

Claims 1-20 are pending in the application. Claim 1 is the only independent claim. Claims 1-12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner believes that the claims are indefinite because “[i]t is unclear what criteria is used in determining probable escheat jurisdiction.” Claim 1 has been amended to indicate that the determination is based on a comparison of street address, city, and zip code with the addresses in the certified data base. This is described in the specification at, e.g., pages 8-13.

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as obvious over McDonald. The McDonald method and system are directed to locating owners of unclaimed property. The data base searching described in the McDonald patent involves searching a name to retrieve an address. See, e.g., col. 9, lines 28-45. The present invention begins with an address and searches a database of certified addresses to determine the probability that the address is a real address. Thus, claim 1 differs from the teachings of McDonald in several ways. First, the aim of McDonald is not to determine the correct escheat state, it is to determine the address of a property owner so that the property can be returned to the owner.

Second, McDonald does not teach or suggest comparing an address to a US Postal Service certified data base. The Examiner cites col. 9, lines 1-4 of McDonald as teaching this part of Claim 1, but McDonald does not teach or suggest this anywhere in the patent. Col. 9, lines 1-4 of McDonald state “[a]t Step 62, a test is conducted to

determine whether an owner of unclaimed property can be located by automatically searching one or more other databases 34, 36, 38 on public 32 and private 16 computer networks.” There is no suggestion here of US Postal Service certified data base and there would not be any reason to use this data base because it does not link names and addresses. It simply verifies the accuracy of the address.

Third, McDonald does not teach or suggest assigning a probable escheat state. The Examiner argues that since it is well known to assign escheat state based on last known address, it would be obvious to modify McDonald to include this step. However, one would first need to modify McDonald’s entire goal of returning property rather than letting it escheat. There is no reason why someone reading the McDonald reference would seek to entirely change the problem that McDonald seeks to solve. In addition, Claim 1 does not assign escheat state based on last known address, it assigns the state based on the correctness of the last known address.

Claims 2-6 are rejected in view of “official notice”. The Examiner cannot assume that the prior art contains an element when it is not clearly shown in the prior art. See, Ex parte Wolters and Kuypers, 214 U.S.P.Q. 735 (Bd.App. 1979) (Examiner's burden of supporting his holding of unpatentability is not met by "assuming" the presence of a missing component). MPEP §2144.03(C) provides “If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.” Pursuant to MPEP §2144.03(C), the Applicant respectfully requests that the Examiner cite references for the subject matter of Claims 2-6.

Claims 7-18 appear to be rejected in view of “official notice” even though the phrase is not used in the rejection. Pursuant to MPEP §2144.03(C), the Applicant respectfully requests that the Examiner cite references for the subject matter of Claims 7-18.

It should be noted that Claim 11 has been amended to more particularly explain how confidence codes are assigned.

In rejecting Claim 19, the Examiner states that “McDonald shows generating a report (col. 9, lines 50-60).” Claim 19 depends from Claim 2 and states “generating a report that defines the composition of the abandoned property database and summarizes metrics by the confidence code.” Col. 9, lines 50-63 of McDonald are reproduced below.

“As another example, organization unclaimed property owners can be searched for at Step 62. The Internet is searched at Step 62 to determine the identity of a bank's largest holding companies. A bank holding company is selected. Next, other Internet searches are conducted to learn the current organizational information for the selected bank holding company. It may be determined that the bank holding company has numerous wholly owned subsidiaries, doing business in many states, under different names. The Internet search information may be downloaded to computers 12, 14 that can sort the bank subsidiary information alphabetically, by state or using other types of sorting. The computers 12, 14 are used to conduct searches for the bank holding company name in the unclaimed property database 18, 20. The computers 12, 14 automatically generate a report that may be sent to a Chief Financial Officer ("CFO") or other individual in charge of recovering unclaimed property for the bank holding company at Step 64.”

The report described in the quoted portion of McDonald is a list of unclaimed property which is sent to the owner of the property. The report described in Claim 19 is a list of unclaimed property of many owners together with an identification of the state to which it will escheat and together with a summary of the metrics according to the confidence that the state is the correct state. The report is not intended for a single property owner since it

lists property that is not owned by a single property owner. It is intended for the state agency in charge of escheat property.

The present invention is designed to do a better job than existing solutions and to demonstrate to the States that the reviewer (whether it be a holder of unclaimed property or an auditor representing the State(s) has conducted sufficient due-diligence on each account. The due diligence standards that the invention is applying exceed what is required in *Texas v. New Jersey*, or anywhere else for that matter.

Further, the invention is the first formal system and set of standards that the States signed-off on to accept alternate reporting jurisdictions based on the variety of changes (or potential changes) to each address and their corresponding error ranges and confidence codes. What this means is that rather than an incredible amount of assets incorrectly (but possibly legally) being escheated to the holder's State of Incorporation by default (or another State in error), the invention instead helps facilitate the delivery of assets to the State where the owner was likely to have last been known to reside. While this is the goal of *Texas v. New Jersey*, practically speaking, there was no effective way to do this without exhaustive manual research which is not feasible on all but very high-value assets. The present invention automates the process and allows more accurate determinations to be made *en masse* in an automated fashion, regardless of account value.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Finally, Applicant hereby requests a one month extension of time in which to respond to the outstanding Office Action. Credit Card payment form no. PTO-2038 in the amount of \$60.00 is enclosed to cover the official fee . Any fee deficiency or overpayment may be charged or credited to Deposit Account No.50-3990.

Respectfully submitted,

THOMAS BERGER



Thomas M. Galgano, (27,638)
GALGANO & ASSOCIATES, PLLC
Attorneys for Applicant
20 West Park Avenue, Suite 204
Long Beach, New York 11561
Telephone: 516.431.1177

TMG/jgg

Enclosure: USPTO Form 2038 in the amount of \$60.00
Postcard

F:\g&b\1685\3\amendment.doc